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EXAMINER

HOEL, MATTHEW D

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/823,829
Filing Date: April 14, 2004
Appellant(s): EVANS ET AL.

Ryan C. Barker
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01-27-2010 appealing from the Office action mailed 05-28-2009.

PRELIMINARY REMARKS

After further consideration, this application contains at least one claim that does not meet the patent eligibility requirement for statutory subject matter under 35 USC 101. Accordingly, this examiner's answer contains a new ground of rejection under 35 U.S.C. 101. Appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed upon appeal is substantially correct. The changes are as follows: Claim(s) 1 to 5, 9 to 17, 19 to 21,

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and 23 to 26 (independent Claims 1, 9, and 14 and their respective dependent claims) are rejected under 35 USC 101 as being directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0045154	WOOD, et al.	04-2002
7,184,969	BONNSTETTER, et al.	02-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5, 7, 9, 11, 13, 16, and 21 to 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Wood, et al. (U.S. pre-grant publication 2002/0045154 A1).

As to Claims 1 and 9: Wood ('154) teaches an analytical method of providing human capital management information (Abst.; used for matching people to appropriate jobs, Paras. 177 & 337). Wood ('154) teaches a plurality of individual capability tests (plural tests, Para. 50; plural types of tests, Keirsey Temperament Sorter and other types, Para. 68; selecting from one of many tests, Para. 76; Paras. 109 to 125 list several types of personality tests available, including the Myers Briggs Type Indicator (113), the Keirsey Temperament Sorter (114)) to rate a plurality of competencies of an individual (competencies measured, Para. 109; competency-based personality data used, Paras. 109 & 117; job listing of competencies for ideal candidate, Para. 177; match based on competencies, Para. 337, see also 347 & 350).

Wood ('154) teaches each of the personality tests being a standardized measure of a psychological construct (plural tests, Para. 50; plural types of tests, Keirsey Temperament Sorter and other types, Para. 68; selecting from one of many tests, Para. 76; Paras. 109 to 125 list several types of personality tests available, including the Myers Briggs Type Indicator (113), the Keirsey Temperament Sorter (114), personality test with 16 personality categories (112, 16 categories each listed in Paras. 210 to 226, 16 permutations of extroversion, sensation, thinking, and judging, 228-231)). Wood teaches obtaining responses to the plurality of questions of each of the plurality of capability tests from the individual (responses gathered to a series of tests, including personality tests, Para. 70). Woods teaches a computer-readable medium for carrying out the method (user logs on to terminal to communicate with server over the network, Figs. 1 & 2, Paras. 67 & 68).

Wood cross-references the responses relating to one of the personality attributes. This is done by the Keirsey Temperament Sorter in Paras. 195 to 233. Extroversion (E), Introversion (I), Sensation (S), Intuition (N), Thinking (T), Feeling (F), Judging (J), and Perceiving (P) are measured (Paras. 228 to 231). These attributes are cross-referenced to personality types Individualistic (ENFP), Enthusiastic (ENFJ), Ardent (INFP), Poetical (INFJ), Curious (ENTP), Born Leader (ENTJ), Intelligence (INTP), Behind-the-scenes Leader (INTJ), Bold (ESTP), Life of the Party or Impulsive (ESFP), Adventurous (ISTP), Kind (ISFP), Pillar of the Community or Responsible (ESTJ), Team Player (ESFJ), Dependable (ISTJ), and Sincere (ISFJ) (Paras. 211 to 226, respectively), so these four attributes are cross-references to 16 personality types or competencies.

Wood in Para. 380 describes cross-referencing and matching similar answer patterns and behaviors stored in databases 2600 and in Para. 381 gives an example of cross-referencing or correlating stock trading history and click histories indicating that the user is only interested in certain industries. Based on the correlation in Para. 381 recommendations are made to improve the user's trading and the system notes which articles the viewer saw to that others like him can see the same reports and articles. The cross-referencing of trading history and click history is an example of correlating attributes from a plurality of individual capability assessments. The examiner notes that Wood would thus cross-reference the responses relating to one of the plurality of attributes from at least two of the plurality of individual capability tests (Para. 223 describing the Keirsey Temperament Sorter, ESTJ, pillar of the community, industrious,

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conscientious, responsible; Para. 243 describing the Keirsey Character Sorter, Supervisor or ESTJ, pillar of the community, industrious, conscientious, responsible), so Wood in '154 anticipates this newly claimed limitation.

Para. 260 of Wood states that where a user would like to know his or her financial personality the use of the Keirsey Temperament Sorter together with other personality models and that when plural models are combined that a new categorization scale is created, so Wood does correspond responses relating to one of the plurality of attributes from at least two of the plurality of individual capability tests. Wood creates a comprehensive individual capability evaluation reports that rates the plurality of competencies, the report being at least partially based upon the cross-referring of the responses (Keirsey Character Sorter and Keirsey Temperament Sorter cross-referenced as outlined above), and provides the comprehensive individual capability evaluation to the individual (employment matching report based on selection of traits, skills, and competencies to a potential employer, Para. 337; or career action plan to tell employee how to get along with boss, Paras. 337 to 309) by a display screen (user logs in at a computer terminal to take the Keirsey Temperament Sorter, Paras. 1 & 2, Paras. 67-68).

As to Claim 5: Wood teaches a computer server for providing human capital management across a computer network (Abst.; Figs. 1 & 2, Paras. 67-68). Wood teaches means for providing a plurality of individual capability tests (plural tests, Para. 50; plural types of tests, Keirsey Temperament Sorter and other types, Para. 68; selecting from one of many tests, Para. 76; Paras. 109 to 125 list several types of

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personality tests available, including the Myers Briggs Type Indicator (113), the Keirsey Temperament Sorter (114)) to rate a plurality of competencies of an individual (competencies measured, Para. 109; competency-based personality data used, Paras. 109 & 117; job listing of competencies for ideal candidate, Para. 177; match based on competencies, Para. 337, see also 347 & 350), the individual competency tests each having a plurality of questions used to assess a plurality of attributes associated with at least one of a plurality of competencies, each of the individual capability tests being a standardized measure of a psychological construct (plural tests, Para. 50; plural types of tests, Keirsey Temperament Sorter and other types, Para. 68; selecting from one of many tests, Para. 76; Paras. 109 to 125 list several types of personality tests available, including the Myers Briggs Type Indicator (113), the Keirsey Temperament Sorter (114), personality test with 16 personality categories (112, 16 categories each listed in Paras. 210 to 226, 16 permutations of extroversion, sensation, thinking, and judging, 228-231)).

Wood teaches means for obtaining responses to the plurality of questions of each of the plurality of individual capability tests from the individual (responses gathered to a series of tests, including personality tests, Para. 70). Wood teaches means for cross-referencing the responses relating to one of the plurality of attributes from at least two of the plurality of individual capability tests to create a comprehensive individual capability evaluation that rates the plurality of competencies (Paras. 223, 243, 260, 380-381, as applied in the rejection of Claims 1 and 9). The examiner finds the structure of the means-plus-function language of the specification at Para. 25, 27-29, 34-36 to be

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equivalent in function to the structure of Wood cited above. To be novel, the apparatus claims must be structurally distinguishable over the prior art and the manner of operating the device does not differentiate claims over the prior art (MPEP 2114). For example, Para. 25 of the appellants' specification corresponds to Figs. 1 & 2 and Paras. 67 & 68 of Wood.

As to Claims 3, 7, 11, and 16: The plurality of questions of Wood pertain to initiative (take-charge, Para. 216) and energized team-building (gregarious, team player, Para. 224).

As to Claim 13: Wood teaches the providing step including an interactive computer server accessible over a computer network (Figs. 1 & 2, Paras. 67 & 68).

As to Claims 21 to 24: Wood asks questions pertaining to creativity (Paras. 109 & 123), motivation (Paras. 98 & 107), and innovation (Paras. 215 & 255).

As to Claims 25 to 28: Wood maps a first question from a first test of the plurality of tests to a first competency and maps a second question from a second test of the plurality of tests to the same competency. Wood measures a plurality of the attributes pertaining to a plurality of competencies. The Keirsey Temperament Sorter (Paras. 195 to 233, a first of a plurality of tests) and the Keirsey Character Sorter (Paras. 234 to 256, a second of a plurality of tests) each measure 16 personality types or competencies based on various combinations of eight attributes, the attributes being extroversion versus introversion, sensation versus intuition, thinking versus feeling, and judging versus perceiving (Paras. 228 to 231). The sixteen personality types measured by these two tests are the same (ENFP, ENFJ, INFP, INFJ, ENTP, ENTJ, INTP, INTJ,

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ESTP, ESFP, ISTP, ISFP, ESTJ, ESFJ, ISTJ, ISFJ, see Paras. 211 to 226

corresponding to Paras. 237 to 256, explaining each personality type). The results for these types can be calculated and presented for the Keirsey Temperament Sorter (Para. 233) and for the Keirsey Temperament Sorter. Two tests can be combined for a combined correlation and output (Para. 260).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4, 6, 8, 10, 12, 14, 15, and 17 to 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over '154 in view of Bonnstetter, et al. (U.S. patent 7,184,969 B1).

As to Claim 14: Wood discloses all of the limitations of Claim 14, but lacks specificity as to an individual action plan containing a listing of transformational activities

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for enabling the individual to improve identified competencies on the comprehensive individual capability evaluation. Wood ('154) teaches an analytical method of providing human capital management information (Abst.; used for matching people to appropriate jobs, Paras. 177 & 337). Wood ('154) teaches a plurality of individual capability tests (plural tests, Para. 50; plural types of tests, Keirsey Temperament Sorter and other types, Para. 68; selecting from one of many tests, Para. 76; Paras. 109 to 125 list several types of personality tests available, including the Myers Briggs Type Indicator (113), the Keirsey Temperament Sorter (114)) to rate a plurality of competencies of an individual (competencies measured, Para. 109; competency-based personality data used, Paras. 109 & 117; job listing of competencies for ideal candidate, Para. 177; match based on competencies, Para. 337, see also 347 & 350).

Wood ('154) teaches each of the personality tests being a standardized measure of a psychological construct (plural tests, Para. 50; plural types of tests, Keirsey Temperament Sorter and other types, Para. 68; selecting from one of many tests, Para. 76; Paras. 109 to 125 list several types of personality tests available, including the Myers Briggs Type Indicator (113), the Keirsey Temperament Sorter (114), personality test with 16 personality categories (112, 16 categories each listed in Paras. 210 to 226, 16 permutations of extroversion, sensation, thinking, and judging, 228-231)). Wood teaches obtaining responses to the plurality of questions of each of the plurality of capability tests from the individual (responses gathered to a series of tests, including personality tests, Para. 70). Woods teaches a computer-readable medium for carrying

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out the method (user logs on to terminal to communicate with server over the network, Figs. 1 & 2, Paras. 67 & 68).

Wood cross-references the responses relating to one of the personality attributes. This is done by the Keirsey Temperament Sorter in Paras. 195 to 233. Extroversion (E), Introversion (I), Sensation (S), Intuition (N), Thinking (T), Feeling (F), Judging (J), and Perceiving (P) are measured (Paras. 228 to 231). These attributes are cross-referenced to personality types Individualistic (ENFP), Enthusiastic (ENFJ), Ardent (INFP), Poetical (INFJ), Curious (ENTP), Born Leader (ENTJ), Intelligence (INTP), Behind-the-scenes Leader (INTJ), Bold (ESTP), Life of the Party or Impulsive (ESFP), Adventurous (ISTP), Kind (ISFP), Pillar of the Community or Responsible (ESTJ), Team Player (ESFJ), Dependable (ISTJ), and Sincere (ISFJ) (Paras. 211 to 226, respectively), so these four attributes are cross-references to 16 personality types or competencies.

Wood in Para. 380 describes cross-referencing and matching similar answer patterns and behaviors stored in databases 2600 and in Para. 381 gives an example of cross-referencing or correlating stock trading history and click histories indicating that the user is only interested in certain industries. Based on the correlation in Para. 381 recommendations are made to improve the user's trading and the system notes which articles the viewer saw to that others like him can see the same reports and articles. The cross-referencing of trading history and click history is an example of correlating attributes from a plurality of individual capability assessments. The examiner notes that Wood would thus cross-reference the responses relating to one of the plurality of

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attributes from at least two of the plurality of individual capability tests (Para. 223 describing the Keirsey Temperament Sorter, ESTJ, pillar of the community, industrious, conscientious, responsible; Para. 243 describing the Keirsey Character Sorter, Supervisor or ESTJ, pillar of the community, industrious, conscientious, responsible), so Wood in '154 anticipates this newly claimed limitation.

Para. 260 of Wood states that where a user would like to know his or her financial personality the use of the Keirsey Temperament Sorter together with other personality models and that when plural models are combined that a new categorization scale is created, so Wood does correspond responses relating to one of the plurality of attributes from at least two of the plurality of individual capability tests. Wood creates a comprehensive individual capability evaluation reports that rates the plurality of competencies, the report being at least partially based upon the cross-referring of the responses (Keirsey Character Sorter and Keirsey Temperament Sorter cross-referenced as outlined above), and provides the comprehensive individual capability evaluation to the individual (employment matching report based on selection of traits, skills, and competencies to a potential employer, Para. 337; or career action plan to tell employee how to get along with boss, Paras. 337 to 309) by a display screen (user logs in at a computer terminal to take the Keirsey Temperament Sorter, Paras. 1 & 2).

Wood in '154 does not cite an individual action plan containing a listing of transformational activities for enabling the individual to improve identified competencies on the comprehensive individual capability evaluation. Bonstetter, however, in '969 cites a listing of identified competencies on the comprehensive individual capability

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evaluation that need improvement (possible developmental needs: selecting best solution based on analysis of data, inspire and lead others, anticipate barriers or problems, contribute to team effectiveness, and involve others in decisions which affect the, Fig. 18E, 15:46-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine this with the career advice disclosed by Wood ('154) in Paras. 307 to 309 to produce the creation of an individual action plan containing a list of transformational activities to improve identified competencies. While Bonstetter does not cite cross-referencing competencies across plural tests, it is analogous art to Wood in that it discusses cross referencing competencies a cross plural subtests to develop a desired profile for an ideal employee. Fig. 12B of Bonstetter asks the user's opinion of his or her personality type (15:8-9) in a first section.

In a second section, Bonstetter asks the user for his or her opinions (Figs. 12C-F) while a third section (Figs. 12G-K) asks a user what he or she has actually done on the job (15:8-12), so these are three types of subtests within the same competency test. Regarding charisma/personal magnetism, the first competency of Fig. 12B, this is measured in section 3 at question 39 (leadership outside of work, Fig. 12J) and at question 6 (people have taken risks to support my goals, Fig. 12G) and in section 2 at question 8 (would not want responsibility of getting others to work towards goals, Fig. 12). Mentor/Facilitator, the second competency of 12B is measured in section 2 at question 10 (Fig. 12D) and question 28 (Fig. 12E) and in section 3 at question 3 (Fig. 12G) and question 41 (Fig. 12J). The results for the attributes corresponding to the

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competencies are cross-referenced between the two types of subtests at Fig. 13 in Bonstetter (15:20-25). Since the two references are thus analogous, the examiner believes that one of ordinary skill in the art would have wanted to use the feedback survey to identify areas that need improvement and thus provide a feedback plan for improvement to the user instead of just providing feedback how to improve a specifically solicited area, such as the employee asking how to improve relations with his boss (Wood, '154, Paras. 307-309) because this would have the advantage of proactively showing an employee how to improve his or her competencies instead of passively waiting for feedback from an evaluation, which may only come as infrequently as once per year.

As to Claims 2, 6, 12, and 15: Bonstetter discloses a cross-referencing step includes creating a plurality of hallmark analysis within the comprehensive individual capability evaluation, each one of the plurality of hallmark analysis relating to a specific quality of the individual (Bonstetter, Figs. 7E, 8E, 9E, and 10E, each individual scored in multiple competencies).

As to Claims 4, 8, and 10: The combination of Wood and Bonstetter renders obvious the individual action plan containing a list of transformational activities to improve identified areas for the reasons outlined in the last paragraph of the rejection of Claim 14.

As to Claims 17 to 20: Bonstetter discloses cross-referencing the competencies relating to a particular attribute to create a comprehensive individual capability evaluation report relating to the attributes (Bonstetter, Figs. 17, 18A-D,

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comprehensive report of five attributes pertaining to loyalty (questions 1-5), five attributes pertaining to teamwork (questions 6-10), and five attributes pertaining to problem solving (questions 11 to 15; 15:55-64).

NEW GROUND(S) OF REJECTION

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1 to 5, 9 to 17, 19 to 21, and 23 to 26 (independent Claims 1, 9, and 14 and their respective dependent claims) are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

Independent Claims 1 and 14 are method claims that are not drawn to any particular apparatus as required by *Bilski*. As required by page 10 of the recent *Bilski* decision (Court of Appeals for the Federal Circuit, 2007-1130), all claims must be either tied to a particular apparatus or to a physical transformation of matter from one composition to another. Physical transformations are seldom encountered in the educational arts (Class 434). The examiner points the appellants to *ex parte Cornea-Hasegan* (89 USPQ2d 1557) and *ex parte Halligan* (89 USPQ2d 1355). Citing how the specific structures of the apparatus perform corresponding specific game steps can

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serve to tie the system to a particular apparatus. Incorporating these structures from the specification into the method Claims 1 and 14 and showing how these structures serve to perform the respective steps of the game and its claimed marketing and promotional aspects would serve to tie the method claim to a particular apparatus.

Paras. 14 to 17 of the specification, 2004/0202988 A1, discuss computer embodiments of the appellants' invention. Claims 5 to 8 of the specification as originally filed outline a computer server for performing the appellants' invention. The method claims meaningfully tied to these particular structures would most likely make Claims 1 and 14 101-compliant. These are only suggestions. The examiner notes that a concrete or tangible action or method step taken by an apparatus structure can serve to tie the claim to a particular apparatus. Exact suggestions are hard to provide, as the examiner is unsure how the appellant will want to amend the claims in light of Bilski. For typical claims pertaining to an educational apparatus, the examiner will provide suggestions as accepting input from a user via an input device on the educational apparatus, such as a touchscreen, keyboard, mouse, buttons, joystick, or trackball; manipulating the input data in physical memory by the educational apparatus's processor according to the rules of the lesson plan, test, or curriculum stored in memory; and displaying the output such as a test score or lesson result to the user via an output device on the educational apparatus such as a display. Such limitations serve to tie the claim to a particular apparatus by showing how the respective structures of the apparatus carry out the respective steps of the method. The structural limitations must be meaningful to the claim as a whole and not trivial, as outlined above.

Claim 9 should be amended to cite "a computer-readable medium storing *non-transitory* instructions which, when executed by a computer, cause the computer to perform the steps of..." See MPEP 2106 (IV)(B) discussing *in re Nuijten*. The claim is presently unclear as to whether the instructions are transitory, such as signals, or non-transitory, such as instructions stored on a non-volatile medium. The examiner believes it would be simple for the appellants to amend the claims to obviate 101, so the 101 rejections can be withdrawn, and the prior art rejections most likely being maintained for decision by the Board.

(10) Response to Argument

The appellants' arguments filed in the appeal brief of 01-27-2010 have been fully considered but they are not persuasive. The examiner believes that Wood anticipates the presently claimed cross-referencing for the following reasons. Wood cross-references the responses relating to one of the personality attributes. This is done by the Keirsey Temperament Sorter in Paras. 195 to 233. Extroversion (E), Introversion (I), Sensation (S), Intuition (N), Thinking (T), Feeling (F), Judging (J), and Perceiving (P) are measured (Paras. 228 to 231). These attributes are cross-referenced to personality types Individualistic (ENFP), Enthusiastic (ENFJ), Ardent (INFP), Poetical (INFJ), Curious (ENTP), Born Leader (ENTJ), Intelligence (INTP), Behind-the-scenes Leader (INTJ), Bold (ESTP), Life of the Party or Impulsive (ESFP), Adventurous (ISTP), Kind (ISFP), Pillar of the Community or Responsible (ESTJ), Team Player (ESFJ),

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Dependable (ISTJ), and Sincere (ISFJ) (Paras. 211 to 226, respectively), so these four attributes are cross-references to 16 personality types or competencies.

Wood in Para. 380 describes *cross-referencing* and matching similar answer patterns and behaviors stored in databases 2600 and in Para. 381 gives an example of cross-referencing or correlating stock trading history and click histories indicating that the user is only interested in certain industries. Based on the correlation in Para. 381 recommendations are made to improve the user's trading and the system notes which articles the viewer saw to that others like him can see the same reports and articles. The cross-referencing of trading history and click history is an example of correlating attributes from a plurality of individual capability assessments.

The examiner notes that Wood would thus cross-reference the responses relating to one of the plurality of attributes from at least two of the plurality of individual capability tests (Para. 223 describing the Keirsey Temperament Sorter, ESTJ, pillar of the community, industrious, conscientious, responsible; Para. 243 describing the Keirsey Character Sorter, Supervisor or ESTJ, pillar of the community, industrious, conscientious, responsible), so Wood in '154 anticipates this claimed limitation. Para. 260 of Wood states that where a user would like to know his or her financial personality the use of the Keirsey Temperament Sorter together with other personality models and that when plural models are combined that a new categorization scale is created, so Wood does correspond responses relating to one of the plurality of attributes from at least two of the plurality of individual capability tests.

Wood creates a comprehensive individual capability evaluation reports that rates the plurality of competencies, the report being at least partially based upon the cross-referring of the responses (Keirsey Character Sorter and Keirsey Temperament Sorter cross-referenced as outlined above), and provides the comprehensive individual capability evaluation to the individual (employment matching report based on selection of traits, skills, and competencies to a potential employer, Para. 337; or career action plan to tell employee how to get along with boss, Paras. 337 to 309).

Wood does measure competencies (competencies measured, Para. 109; competency-based personality data used, Paras. 109 & 117; job listing of competencies for ideal candidate, Para. 177; match based on competencies, Para. 337, see also 347 & 350). Wood does measure a plurality of the attributes pertaining to a plurality of competencies. The Keirsey Temperament Sorter (Paras. 195 to 233) and the Keirsey Character Sorter (Paras. 234 to 256) each measure 16 personality types or competencies based on various combinations of eight attributes, the attributes being extroversion versus introversion, sensation versus intuition, thinking versus feeling, and judging versus perceiving (Paras. 228 to 231).

The examiner believes the personality types described by the Keirsey Sorters are competencies rather than attributes because the name of each personality type describes something that is actually done instead of merely an intrinsic quality (Promoter, Crafter, Performer, Composer, etc., Paras. 237-256). The attributes extroversion versus introversion, sensation versus intuition, thinking versus feeling, and

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judging are not so much things that are actively done but personality traits, 3which may lead to action, extroversion being a good example.

The examiner believes the Wood reference does disclose cross-referencing for the reasons outlined in the rejection of Claim 1. Cross referencing is mentioned in Para. 380. Wood is describing cross-referencing and matching similar answer patterns and behavior stored in databases 2600, which would be for example, the results of the Kiersey Temperament Sorter, the Keirsey Character Sorter, and the Myers Briggs Type Indicator. The providing of constructive feedback in identified areas to the user is obvious for the reasons outlined in the rejection of Claim 14. Wood teaches providing feedback in the form of advice to a user in a particular solicited area, getting along with one's supervisor, in Paras. 307-309. Bonnstetter in Figs. 18A-H and 15:55-64 identifies specific areas that need improvement and suggests employees using the information to develop the competencies relevant to the job (15:61-62). The examiner believes this would have the advantage of making the Wood system more useful by allowing the employees to actively find out the areas they need advice in by diagnosis rather than merely asking about a particular area.

Regarding cross-referencing one of the plurality of attributes (in this case, the sixteen attributes or competencies of Wood) from at least two of the plurality of individual capability tests, Wood maps a first question from a first test of the plurality of tests to a first competency and maps a second question from a second test of the plurality of tests to the same competency. Wood measures a plurality of the attributes pertaining to a plurality of competencies. The Keirsey Temperament Sorter (Paras. 195

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to 233, a first of a plurality of tests) and the Keirsey Character Sorter (Paras. 234 to 256, a second of a plurality of tests) each measure 16 personality types or competencies based on various combinations of eight attributes, the attributes being extroversion versus introversion, sensation versus intuition, thinking versus feeling, and judging versus perceiving (Paras. 228 to 231). The sixteen personality types measured by these two tests are the same (ENFP, ENFJ, INFP, INFJ, ENTP, ENTJ, INTP, INTJ, ESTP, ESFP, ISTP, ISFP, ESTJ, ESFJ, ISTJ, ISFJ, see Paras. 211 to 226 corresponding to Paras. 237 to 256, explaining each personality type). The results for these types can be calculated and presented for the Keirsey Temperament Sorter (Para. 233) and for the Keirsey Character Sorter. Two tests can be combined for a combined correlation and output (Para. 260).

The examiner believes that the stock trading history or click history are fairly tests in that they are both measured and that they are compared to "standard tests" such as the Keirsey Temperament Sorter and the Keirsey Character Sorter (Paras. 260 & 261): "For example, where a user would like to know his/her financial personality, use of the Keirsey Temperament Sorter together with other personality models and other data gathered from module 1000 would allow the system to further classify the user to measure personality dimensions such as risk aversion, anxiety, contentment, and altruism. Such personality dimensions are not best measured by the Keirsey Temperament Sorter and may not have Financial Personality implications by themselves. *However, when combined with the Keirsey Temperament Sorter or any other test, a new categorization scale is created.* ¶ The algorithm selected at 2400 can

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also take behavior and action information from module 1000 and convert it into a standardized format. For example, the system analyzes the users stock trading history and then converts the history into a series of alpha numeric scores that represent the size of the trades, the frequency of the trades, and the holding period. These numbers are used alone or with other data gathered to score the dimensions used for financial personality type and may indicate that the user is a day trader. Similarly, the system analyzes purchase history in order to categorize users.” (emphasis added by examiner)

The examiner respectfully disagrees with the appellants as to the claims’ condition for allowance.

Regarding the appellants’ comments on pages 8 and 9 of the brief, no detailed analysis is made of how Wood's specification is not enabling. The factors for undue experimentation pertaining to enablement include a) the breadth of the claims, b) the nature of the invention, c) the state of the prior art, d) the level of one of ordinary skill, e) the level of predictability in the art, f) the amount of direction provided by the inventor, g) the existence of working examples, and h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure (MPEP 2164.01(a) discussing *in re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). No detailed analysis of Wood is made by the appellants in light of the Wands factors. The prior art is presumed to be enabling unless shown otherwise (MPEP 2121). The appellants on page 8 are quoting from Para. 50 of Wood: “Still another advantage of the present invention is that it makes possible the creation and delivery of content, advice, and people profiles

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determined from a user's responses to a series of personality tests, demographics questions, both on-line and off-line behavior, psychographic testing, life style and quality of life questions." The examiner did not use the term "possible" in regard to Wood in the final rejection or in the advisory action. The examiner believes that Wood does enable, or make possible the delivery of content and advice based on a user's responses to a series of personality tests, and so forth, as Wood describes in Para. 50. Wood describes a plurality of personality tests including the Keirsey Temperament Sorter (Para. 195) and the Keirsey Character Sorter (Para. 235). Wood uses these tests to dispense career advice to the user (Para. 307). Wood describes how employers can use Wood's system to select appropriate candidates for open positions (Para. 237). Wood in Fig. 11 outlines Module 3200B ("Advice Matching Algorithm"), a flowchart used for dispensing career advice to the user, described in Paras. 304 to 313. The examiner points the appellants to *Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, 86 USPQ2d 1235 (Fed. Cir. 2008) at 1242 & 1243 in which Aristocrat did not disclose an algorithm for performing the claimed function. The examiner believes that Wood's algorithm in Fig. 11's flowchart and the corresponding description meets the enablement requirement and would not require any undue experimentation. The examiner also believes that Fig. 12 (Module 3200C, "People Matching Algorithm") described at Paras. 314 to 340 of Wood meets the enablement criteria for Wood's described use of the test results for employee matching.

The appellants on pages 8 and 9 of the brief mention *Impax Laboratories Inc. v. Aventis Pharmaceuticals Inc.*, 88 USPQ2d 1381 (Fed. Cir. 2008). Impax at 1383 discusses how the '940 prior art reference's Formula I encompassed a particularly large number of compounds, and for this reason, among others, was not enabling prior art reference at 1384. Wood at Para. 306 mentions a large number of possible tests for module 3200B of Fig. 11: Keirsey Temperament Sorter, Enneagram, Skills Tests, IQ Tests, etc. The examiner does not believe this an unduly large number of tests. Specific use of the Keirsey Temperament Sorter for the purposes of Fig. 11 is described in Paras. 307 to 310 of Wood. The examiner thus believes the Impax case does not bear on the present claims or the enablement of Wood as a prior art reference. Similar considerations will apply to Wood (Fig. 12, Module 3200C, Paras. 314 to 337), especially Para. 337 additional personality or skills tests to be used for job matching.

Regarding the appellants' remarks at the bottom of page 9 and the top of page 10, the examiner notes that "capability" has connotations of possibility or potential, or what can be done. Capable: having ability or capacity; having the requisite mental or physical capacity; open or susceptible to (Webster's II New Riverside University Dictionary, Riverside Publishing Co., Houghton Mifflin, Boston, Mass., 1984). "Competency" has connotations of what has been done. Competent: properly qualified; adequate for the stipulated purpose (Webster's II New Riverside University Dictionary, Riverside Publishing Co., Houghton Mifflin, Boston, Mass., 1984). The examiner does not believe this distinction, however, pertains to the claims as presently cited, as the claims do not appear to further develop the present natures of the competencies or the

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potential or future natures of the capabilities. Describing the Keirsey Temperament Sorter (Paras. 195 to 233), Wood describes what the examiner believes to be competencies: Extroversion (E), Introversion (I), Sensation (S), Intuition (N), Thinking (T), Feeling (F), Judging (J), and Perceiving (P) (Paras. 228 to 231). These competencies are something already pertaining to the individual, since they are measured by the test. Wood in Paras. 210 to 226 correlates various permutations of these eight competencies to sixteen personality models, which the examiner believes to be capabilities, or potential future performance, such as the employee career advice of Wood Para. 307, or the employee matching of Wood Para. 337:

"[0211] 1. ENFP--(Individualistic, unconventional, spontaneous, exuberant, freedom, variety, intuitive)

[0212] 2. ENFJ--(Enthusiastic group leaders, creative, sincere, articulate, expressive, dramatic, nurturing)

[0213] 3. INFP--(Ardent idealism, moral, romantic, poetic, selfless, conscience-stricken, adaptable)

[0214] 4. INFJ--(Poetical, creative, psychic, romantic, loving, sensitive)

[0215] 5. ENTP--(Curious, pragmatic, innovative, non-conformist, intellectually competitive)

[0216] 6. ENTJ--(Born leader, take-charge)

[0217] 7. INTP--(Intelligent, obsessive, even-tempered, autonomy, debate, understanding, shy)

[0218] 8. INTJ--(Behind the scenes leader)

[0219] 9. ESTP--(Bold, aggressive, entrepreneurial, charismatic)

[0220] 10. ESFP--(Life of the party, impulsive, center of attention, Epicurean--pleasure and variety)

[0221] 11. ISTP--(Adventure, excitement, loners, fraternal, freedom, impulsive)

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[0222] 12. ISFP--(Kind, sympathetic, absorbed, artsy, non-verbal)

[0223] 13. ESTJ--(Pillars of the community, industrious, conscientious, responsible)

[0224] 14. ESFJ--(Team player, gregarious, faithful, contributor, people-pleaser)

[0225] 15. ISTJ--(Dependable, down-to-earth, traditional, dedicated, trustworthy, stable, committed)

[0226] 16. ISFJ--(Sincerity, seriousness, humility, social ranking, status)"

These different personality types will necessarily have different aptitudes or capabilities for different career fields. For example, Wood (Paras. 260 to 282) discusses using the Keirsey Temperament Sorter to determine a user's financial personality (Para. 260), further describing the use of the Keirsey Temperament Sorter in job matching. The system of Wood is thus used to measure competencies or present attributes to determine capabilities for potential career performance.

Regarding the appellants' remarks on page 10 pertaining to a rating report that rates a plurality of competencies, the examiner believes the outline in the preceding paragraph outlines a report describing a plurality of capabilities for potential career performance, in for example the financial field. Wood in Paras. 263 to 271 describes personality models or capabilities useful for potential financial career success: Clan Financier, Heedful, Nonconformist, Incognito, Competitor, Aristocrat, Treasurer, Experimenter, and Intellectual. These are derived from the characteristics or already-present competencies of (Paras. 273 to 279): Participation, Anxiety, Power, Risk Taking, Trust, Control, and Knowledge. The examiner believes the database presented

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to the potential employer at Wood Para. 337 fairly constitutes a report for these purposes. See for example, the results presented by text, audio, or video by the system at Para. 335.

Regarding the comments pertaining to the comprehensive report on page 10, Wood creates a comprehensive individual capability evaluation reports that rates the plurality of competencies, the report being at least partially based upon the cross-referring of the responses (Keirsey Character Sorter and Keirsey Temperament Sorter cross-referenced as outlined above), and provides the comprehensive individual capability evaluation to the individual (employment matching report based on selection of traits, skills, and competencies to a potential employer, Para. 337; or career action plan to tell employee how to get along with boss, Paras. 337 to 309) by a display screen (user logs in at a computer terminal to take the Keirsey Temperament Sorter, Paras. 1 & 2, Paras. 67-68). Wood at Paras. 318 to 325 describes the personnel matching of Fig. 12, in which the individuals are rated by capability or personality model (e.g, person 1: ENFP). Wood at Paras. 326 to 334 describes how the individuals are rated on respective scales for the respective competencies or attributes (e.g., person 1: E=6, I=4). This information is presented to the potential employer at Paras. 334 and 335. The examiner believes this is a comprehensive evaluation report that rates the plurality of competencies and provides the comprehensive individual capability evaluation to the individual. Regarding the appellants' comments on pages 11 and 12 regarding Claims 5, 9, and 14, these issues have been addressed above.

Regarding the affidavits discussed on page 12, the examiner believes that he has made every effort to thoroughly analyze the claims and the references, and has made every effort to interpret the claim language fairly (see discussion of “competency” and “capability” above). The examiner is an electrical engineer by training with seven years of experience in aircraft simulation and five years of experience as an examiner, and not a licensed psychologist like Dr. Colquitt. The affidavits of 10-10-2006, 07-20-2007, 03-03-2008, 07-18-2008, and 09-28-2009, are for the most part, copies of journal articles and book chapters, along with Mr. Colquitt’s analyses of Wood and Bonnstetter’s disclosures and not sufficiently analyzing the claim language in light of the references, particularly the meanings of competency, capability, and cross-referencing. These terms have not been sufficiently developed in the claim language to overcome the prior art. The affidavits of 01-27-2010 (signed on pages 9 and 15 as scanned into IFW) were previously entered on 03-03-2008 and 07-18-2008 and were addressed in the office actions of 04-18-2008 (pages 16 to 18) and 11-06-2008 (pages 16 to 19). The examiner believes he has made every effort to interpret the claim language as broadly as reasonable and to not read the limitations of the specification into the claims (MPEP 904.01, 2111). For the reasons outlined in the rejections above and the above discussion regarding Wood’s enablement, the examiner believes that the plain language of the references speaks for itself in light of the present claims. Per MPEP 1206 and 37 CFR 41.33(c)(1), the appellants have not presented any affidavits not previously made along with good reason why they could not have been earlier presented, so the examiner will not address the affidavits further.

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Regarding the appellants' remarks on page 12 regarding Bonnstetter, Bonstetter is used for the same career advice (Wood, Fig. 11, Paras. 304 to 313) and employee matching functions (Wood, Fig. 12, Paras. 314 to 337) as Wood. Bonnstetter (15:45-16:7):

"(3) Feedback Survey ¶ It can also be advantageous for a company to track the performance of an employee. System 10 allows this as follows. Periodically, an employee functioning in a position, as well as others such as a superior, one or more subordinates, or one or more peers, can take a Feedback Survey such as shown in FIGS. 15 17. The competencies previously described are used to evaluate present employees using the Feedback Survey. ¶ (4) Feedback Report ¶ The answers to Feedback Reports 24 of FIGS. 15 17 can then be compiled in a Feedback Report 34 such as shown in FIGS. 18 and 19. The views of others regarding the employee, as well as the employee's own use, are then quantified. Variations in those results can then be compared. This can be very helpful in assisting the employee develop the competencies most important for the job. It can also be used to determine whether a certain employee is not the correct fit for a job. ¶ (6) Interview Candidate Record ¶ FIGS. 20 22 illustrate forms that can be used by an interviewer while interviewing several different candidates for a position. FIGS. 20 and 21 are hypothetical examples for two different candidates for the same job. The top five competencies from the Position Report 30 are set forth in the Interview Candidate Record. Weighting of the importance of the competency to other competencies is set forth, as well as a ranking from the personal competency index taken by the employee."

Bonnstetter outlines a comprehensive report analogous to that of Wood at 15:26-45. Bonstetter in '969 cites a listing of identified competencies on the comprehensive individual capability evaluation that need improvement (possible developmental needs: selecting best solution based on analysis of data, inspire and lead others, anticipate barriers or problems, contribute to team effectiveness, and involve others in decisions which affect the, Fig. 18E, 15:46-64). While Bonstetter does not cite cross-referencing

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competencies across plural tests, it is analogous art to Wood in that it discusses cross referencing competencies a cross plural subtests to develop a desired profile for an ideal employee. Fig. 12B of Bonstetter asks the user's opinion of his or her personality type (15:8-9) in a first section. In a second section, Bonstetter asks the user for his or her opinions (Figs. 12C-F) while a third section (Figs. 12G-K) asks a user what he or she has actually done on the job (15:8-12), so these are three types of subtests within the same competency test. Regarding charisma/personal magnetism, the first competency of Fig. 12B, this is measured in section 3 at question 39 (leadership outside of work, Fig. 12J) and at question 6 (people have taken risks to support my goals, Fig. 12G) and in section 2 at question 8 (would not want responsibility of getting others to work towards goals, Fig. 12). Mentor/Facilitator, the second competency of 12B is measured in section 2 at question 10 (Fig. 12D) and question 28 (Fig. 12E) and in section 3 at question 3 (Fig. 12G) and question 41 (Fig. 12J). The results for the attributes corresponding to the competencies are cross-referenced between the two types of subtests at Fig. 13 in Bonstetter (15:20-25). Since the two references are thus analogous, the examiner believes that one have wanted to used the feedback survey to identify areas that need improvement and thus provide a feedback plan for improvement to the user instead of just providing feedback how to improve a specifically solicited area, such as the employee asking how to improve relations with his boss (Wood, '154, Paras. 307-309) because this would proactively show an employee how to improve his or her competencies instead of passively waiting for feedback from an evaluation, which

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may only come as infrequently as once per year. The examiner respectfully disagrees with the appellants as to the claims' condition for allowance.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Matthew D. Hoel/

Examiner, Art Unit 3714

Conferees:

/Dmitry Suhol/

Supervisory Patent Examiner, Art Unit 3714

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Robert P Olszewski/

Director, Technology Center 3700